

Application No.: 10/762053

Case No.: 53912US011

REMARKS

Claims 1 to 59 are pending. Claims 1 and 30 are amended.

§ 112 Rejections

Claims 2 and 4 stand rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Claims 2 and 4 each further define the claim from which it depends, claims 1 and 3, respectively, and state "wherein said biaxially oriented substrate comprises a monolayer substrate."

Applicants respectfully submit that this claim language is definite and distinctly claims the subject matter. As correctly pointed out, this language does contemplate that additional layers may be part of the substrate, which this claim language makes clear. A multilayer structure is supported by the specification. "Backing 12 alternatively may comprise a multilayer backing, at least one of which layers comprises a biaxially oriented polypropylene film as described herein." (p. 11, ln. 26-28). In summary, Applicants submit that the rejection of claims 2 and 4 under 35 USC § 112, second paragraph, should be withdrawn.

§ 102/103 Rejections

Claims 3, 4, 7-16, 23, 24, 30, 31, 34-44, 51, 52, 54, and 59 stand rejected under 35 USC § 102(b) as anticipated by or, in the alternative, under § 103(a) as being unpatentable over Hufnagel et al. (US Pat. 4,595,738). Claims 1, 2, 5, 6, 17-22, 25-29, 32, 33, 45-50, 53, and 55-58 stand rejected under 35 under § 103(a) as being unpatentable over Hufnagel et al.

To anticipate a claim, a single prior art reference must teach each and every element of the claim. MPEP § 2131. To establish a *prima facie* case of obviousness, three criteria must be met. MPEP § 2143. There must be some suggestion or motivation to modify the reference or to combine reference teachings, there must be a reasonable expectation of success, and the references must teach or suggest all the claim limitations. MPEP § 2143.

Application No.: 10/762053

Case No.: 53912US011

Each of the independent claims requires a melt flow rate of at least 8 grams/10 minutes and a tensile elongation to break of from above about 55% to 170%. These values are physical properties of the backing which define the parameters of the backing Applicants regard as their invention.

Specifically, regarding the rejection of claims 3, 4, 7-16, 23, 24, 30, 31, 34-44, 51, 52, 54, and 59 under § 102(b), Hufnagel et al. discloses an elongation but not an elongation to break within the stated range of the claims. Further, Hufnagel et al. does not disclose any value for a melt flow rate. Therefore, because Hufnagel et al. does not teach each and every element of claims 3, 4, 7-16, 23, 24, 30, 31, 34-44, 51, 52, 54, and 59, these claims are not anticipated by Hufnagel et al.

Claims 1-59 were rejected under 35 under § 103(a) as being unpatentable over Hufnagel et al. As stated above, Hufnagel et al. discloses an elongation but not an elongation to break within the stated range of the claims. Also, Hufnagel et al. does not disclose any value for a melt flow rate. Hufnagel et al. does not teach or suggest optimization of either of these physical properties.

It is desired that severed tape does not chip, sliver, fracture or break in an unpredictable manner. (p. 1, ln. 24-25). Severability is governed primarily by the mechanical properties of the backing of the tape. (p. 1, ln. 26). Tape backing can include various combination of resin and can include other components to the polypropylene resin to improve processing, to improve the severability, or generally to affect the tape backing physical properties. (p. 3, ln. 8-19; p. 14, ln. 8-11). Tape backings can be stretched under various processing conditions and parameters, which affect the tape backing physical properties. (p. 2, ln. 9-20). Modification of the backing composition or modification of processing conditions does not necessarily result in predictable changes to the backing physical properties.

In summary, a *prima facie* case of obviousness has not been made for claims 1-59. Claims 1-59 are patentable over Hufnagel et al. under § 103(a) because there is no suggestion or motivation to modify Hufnagel et al. to arrive at the claimed physical properties. Additionally, Hufnagel et al. does not teach each and every claim limitation.

Application No.: 10/762053

Case No.: 53912US011

Claims 1-59 stand rejected under § 103(a) as being unpatentable over either Wong et al. (US Pat. 4,451,533), Robinson et al. (US Pat. 3,241,662), or Nanbu (US Pat. 4,414,261) in view of Hufnagel et al.

Wong et al. teaches that a tape backing should break before it can be stretched in its longitudinal direction by about 55% and that a tape backing exhibiting this property (among others) was made from homopolymeric isotactic propylene resins having melt flow indices in the range of 0.7 to 4.0 (melt flow rate 0.7 to 4.0 g/10 minutes). Robinson et al. teaches a backing having specified tensile strength and elongation. However, nowhere in Robinson et al. is there a teaching of any specified melt flow rates. Nanbu teaches a isotactic polypropylene that has a preferred melt index of from 0.5 to 4.0 (melt flow rate 0.5 to 4.0 g/10 minutes). Nanbu teaches elongation, not elongation to break, values from 25%-40% (examples). The teachings of Hufnagel et al. were discussed above.

As can be seen, even with a combination of all of these references, not all of the claim limitations are taught or suggested. Further, each independent claim requires a melt flow rate of at least 8 grams/10 minutes. The only references specifically teaching a melt flow rate, only teach of a rate up to 4 g/10 minutes. As stated above, tape backing can include various combination of resin and can include other components to the polypropylene resin to improve processing, improve the severability, or generally affect the tape backing physical properties. (p. 3, ln. 8-19; p. 14, ln. 8-11). Also, tape backings can be stretched under various processing conditions and parameters, which affect the tape backing physical properties. (p. 2, ln. 9-20). Modification of the backing composition or modification of processing conditions does not necessarily result in predictable changes to the backing physical properties.

Even with a combination of the reference, not all of the claim limitations are taught or suggested. Therefore, a *prima facie* case of obviousness has not been made for claims 1-59 in light of Wong et al. (US Pat. 4,451,533), Robinson et al. (US Pat. 3,241,662), or Nanbu (US Pat. 4,414,261) in view of Hufnagel et al.

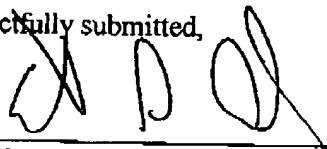
Application No.: 10/762053Case No.: 53912US011

In view of the above, it is submitted that the application is in condition for allowance.
Reconsideration of the application is requested.

Respectfully submitted,

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Date

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